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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,590	09/26/2003	David A. Esposito	ESP-PT001	8656

3624 7590 07/12/2004

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EXAMINER

MENDIRATTA, VISHU K

ART UNIT PAPER NUMBER

3712

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/672,590	Applicant(s) ESPOSITO, DAVID A.	
	Examiner Vishu K Mendiratta	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the game is being played in the absence of providing a proper apparatus/environment. In claim 1 "hypothetical situation has no clear structure. In claim 2, it is not known how to track the limited time. Like wise for all other limitations.

3. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. The claims appear to be a commonly known format of "question –answer –evaluate answer and scoring" widely used in all possible situation.

4. Claims 1-7 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: no proper structure to practice the method.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-15 rejected under 35 U.S.C. 102(b) as being anticipated by Morton (6224057).

Claim 1: Morton teaches providing a situation (Fig.2), a player responding to the situation, answer evaluated by another player (2:27-30), and allocating score (2:65-67).

Claim 2: answering in limited time (2:28-29).

Claim 3: including a master list (2:40-45).

Claim 4: other player presenting advice (warning 10 second is interpreted as advice 2:39-40).

Claim 5: Other player evaluating at the end of turn (all game steps have a limited time in general inherently), this is being understood by the time between one player turn to another player turn.

Claim 6: The player writing notes in the process of playing the game (2:31-35).

Claim 7: Presenting groups of situations (Fig.2).

Claim 8: Board, spaces with situations (Fig.1).

Claim 9: Players taking turn (abstract).

Claim 10: comparing score to be a winner (2:65-67).

Claim 11: Board having situation spaces (Fig.1).

Claim 12: "situation encountered by parents" is subjective and intended use and Morton situations can be seen as encountered by parents and children as well.

Claim 13: Randomly determining and moving on spaces and encountering situations (1:37-42).

Claim 14: Adding points for answering correctly on situation described by the space (1:48-50).

Claim 15: Each player advancing through the game board (abstract).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Morton.

Morton teaches all limitations except that it does not expressly indicate the other player evaluating the answer in a limited time. It is common sense that in order to complete a game in a reasonable amount of time, each step has to be completed in a reasonably limited time. For example no player can take forever to answer a question and for that matter no evaluator can take forever to evaluate an answer. One of ordinary skill in art at the time the invention was made would have suggested allowing limited time to evaluate an answer to complete the game in a reasonably limited time.

Claim 6: Morton teaches the player writing notes in the process of playing the game (2:31-35).

9. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Morton.

Morton teaches all limitations except that it does not expressly teach designating a game over space. In the art area of board games there are art recognized ways a game is considered to be over. Some games are taken as over when a limited time has

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lapsed, some are considered over when all game pieces have gone through the path once to come back to the start space and treating the start space as a game over space. As indicated in Morton all players have to go through the entire path, indicating the start space to be treated as a game over space. One of ordinary skill would have treated the start space as a game over space as well.

10. Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Morton in view of Morris (6019370).

Morton teaches all limitations except that it does not teach awarding extra point for reaching the finish space earlier than others.

Morris teaches awarding extra points for reaching finish space earlier than others (8:37-42).

Board games are highly competitive amusements and allowing players to earn bonus attracts player. In order to attract players to play a game it would have been obvious to use commonly used method steps that are entertaining. One of ordinary skill in art at the time the invention was made would have suggested allowing players to earn extra point by reaching the finish space earlier than others and motivating them to play the game.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carrera teaches start/finish on same space.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (703) 306-5695. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K Mendiratta
Primary Examiner
Art Unit 3712

VKm
July 9, 2004